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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,583	03/23/2004	Jennifer L. Thompson	CN0201USNA	2249
23906	7590	08/25/2006		
E I DU PONT DE NEMOURS AND COMPANY LEGAL PATENT RECORDS CENTER BARLEY MILL PLAZA 25/1128 4417 LANCASTER PIKE WILMINGTON, DE 19805				
			EXAMINER LEE, RIP A	
			ART UNIT 1713	PAPER NUMBER
DATE MAILED: 08/25/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/806,583

Applicant(s)

THOMPSON ET AL.

Examiner

Rip A. Lee

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-10 is/are rejected.
- 7) ☒ Claim(s) 1, 8 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This office action follows a response filed on June 7, 2006. Claims 1-3 and 5-10 are pending. The indicated allowability of claims has been withdrawn in view of the newly discovered references. Rejections based on the newly cited references follow.

#### *Claim Objections*

1. Claim 1 is objected to because of the following informalities: Line 4 of the claim recites an upper limit of molecular weight of 50,000 g/mole. This appears to be a typographical error since the specification indicates that the upper limit is 5000 g/mole. Please make appropriate correction(s) for the inconsistency.
2. Claims 8 and 9 are objected to because of the following informalities: It is not clear whether the recited weight percentages are based on the weight of the total composition or the weight percentages are based on the weight of the total filler only. Appropriate correction is required.

#### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4 and 5-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Makino *et al.* (U.S. 4,229,238).

Makino *et al.* discloses a liquid resin composition comprising (a) 20-70 pw of unsaturated polyester having an average molecular weight between 500-5000, (c) 30-70 pw of an ethylenically unsaturated compound being radically reactive with and being able to dissolve said unsaturated polyester resin (*i.e.*, reactive diluent), (d) 0.05-1 pw of electrically conductive fiber

having length between 1-10 mm, and (e) less than 40 pw of electrically conductive powder having a diameter of 10-300  $\mu\text{m}$  (see claim 1). The unsaturated polyester oligomer has at least two unreactive carboxylic acid end groups (for instance, POLYMAL 9607, MW = 1000, has an acid value of less than 70; see col. 5, lines 60-65), and therefore, the material satisfies the generic polycarboxylic acid component recited in the instant claims. Claim 8 indicates that component (c) is a lower ester of methacrylic acid (*i.e.*, methyl methacrylate). The ratio of fillers (d) and (e) is variable provided that prescribed range is met, and it can be seen from the table in column 5 that the ratio is 30/0.5, or 60/1. Inventive compositions find use in molding applications (col. 6, lines 7-12).

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-4 and 5-10 are rejected under 35 U.S.C. 102(b), or in the alternative, under 35 U.S.C. 103(a) as being obvious over Okuno *et al.* (U.S. 5,281,633).

Okuno *et al.* discloses a liquid composition for production of molded articles comprising unsaturated polyester, 4-methyl-2,4-diphenyl-1-pentene, glass fiber of about 0.05-3 mm in length, glass powder of about 20-350 mesh, and aluminum hydroxide of about 0.2-50  $\mu\text{m}$  in average particle size (claim 1). The composition may also contain crosslinked polystyrene particles (claim 3) having a particle size of 20-50  $\mu\text{m}$  (col. 4, line 1). According to the inventors, the composition is comprised of 10-400 pw of glass fiber, 10-300 pw of aluminum hydroxide, and 1-20 pw of crosslinked polystyrene. The reference is silent with regard to the molecular weight of the unsaturated polyester component, however, in view of the fact that the molding composition is a liquid casting composition wherein the viscosity must be at least  $10^7$  cP at 25  $^{\circ}\text{C}$ , a reasonable basis exists to believe that the unsaturated polyester in Okuno *et al.* exhibits the claimed molecular weight. Since the PTO can not conduct experiments, the burden of proof is shifted to the Applicants to establish an unobviousness difference. *In re Fitzgerald*, 619 F.2d. 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112-2112.02.

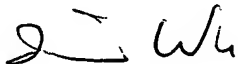
Art Unit: 1713

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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August 21, 2006

  
DAVID W. WU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700